

### REMARKS

Reconsideration of the above-identified application in view of the amendments above and the remarks following is respectfully requested.

Claims 1-19 are in this case, but were presented as claims 1-9 and 11-20. Claim 9 has been rejected under § 112, second paragraph. Claims 1-9 and 11-20 have been rejected under § 102(b) or § 103(a).

Claims 1-19 have now been canceled, being replaced by new independent claims 20, 29 and 34, and dependent claims 21-28, 30-33, 35 and 36. As a result of these amendments, the claims pending in this case will be claims 20-36.

The claims before the Examiner are directed toward a device and method for guiding nails into a surface wherein a flexible membrane with an opening is used to engage and guide the nail. The membrane is sufficiently flexible to allow insertion via the opening of the head of a nail having dimensions greater than dimensions of the opening, thereby providing a simple and intuitive front-loading device. The membrane is deployed relative to abutment features of the device such that, when the device is abutting a surface, the portion of the flexible membrane guiding the nail is spaced away from the surface, thereby holding the nail more reliably than would a membrane flat against the surface.

### Claim Objections

The Examiner has objected to the claims for being numbered non-consecutively. The Examiner has required renumbering of claims 11-20 as claims 10-19. This has now been implemented. However, as will be discussed in more detail below, the Applicant has chosen to cancel all pending claims 1-19, instead replacing them with new claims 20-36. The Applicant believes that the new claims are correctly

consecutively numbered to follow on from the last claim previously of record (renumbered as claim 19), thereby overcoming the Examiner's objections.

**§ 112, Second Paragraph Rejections**

The Examiner has rejected claim 9 under § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Specifically, the Examiner has pointed out a grammatical irregularity in the phrase "a accessory", and has required correction.

The grammatical correction has now been made, appearing in claim 27 which generally parallels now-canceled dependent claim 9. The Applicant believes that the claims are now free from the deficiencies identified by the Examiner under § 112, second paragraph.

**Unidentified Reference – "Hoffman '974"**

Certain rejections by the Examiner rely on a reference referred to as "Hoffman '974". No such reference appears on the "Notice of References Cited" or is otherwise known to the Applicant.

In a good faith effort to advance the prosecution efficiently, the Applicant has independently researched patents with an inventor "Hoffman", and has identified US patent no. 2,866,974 as the most likely document to which the Examiner may be referring. The Applicant's arguments below are based upon the assumption that this is indeed the document to which the Examiner intended to refer. If this is not the case, further clarification is respectfully solicited. The Examiner is also respectfully requested to ensure that the correct document is officially made of record in the file.

**§ 102(b) & § 103(a) Rejections**

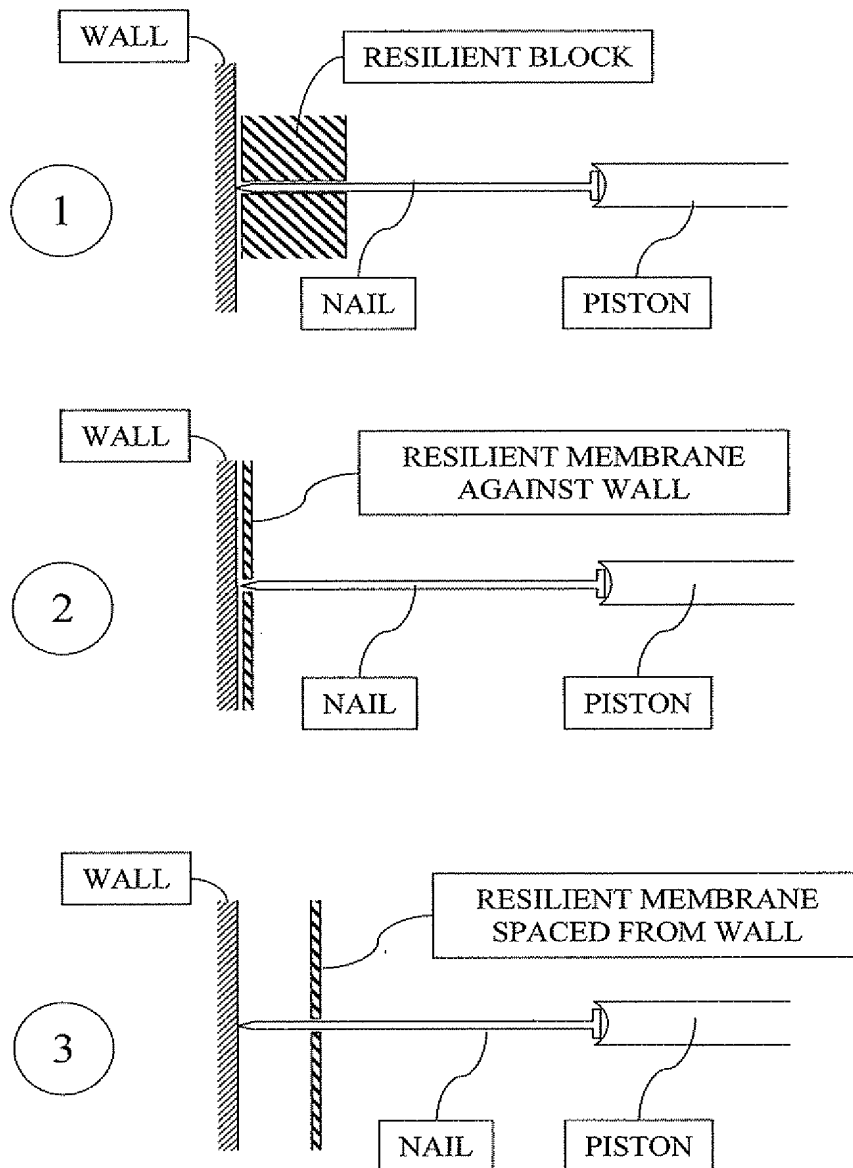
The Examiner has rejected claims 1-4, 8, 12, 13, 15, 17 and 18 under 35 U.S.C. 102(b) as being anticipated by Hilti '209. The Examiner has also rejected claims 1, 2, 4, 7-9, 12-17, 19 and 20 under 35 U.S.C. 102(b) as being anticipated by Fields '755. The Examiner has also rejected claims 1, 2, 4, 8, 9, 12, 13 and 15 under 35 U.S.C. 102(b) as being anticipated by Hoffman '974.

The Examiner has rejected claims 5-7, 14, 15, 19 and 20 under 35 U.S.C. 103(a) as being unpatentable over Hilti '209. The Examiner has also rejected claims 5-7, 14 and 15 under 35 U.S.C. 103(a) as being unpatentable over Hoffman '974. The Examiner has also rejected claims 5 and 6 under 35 U.S.C. 103(a) as being unpatentable over Fields '755. The Examiner has also rejected claim 11 under 35 U.S.C. 103(a) as being unpatentable over Hoffman '974, Fields '755 or Hilti '209 in view of Arena '632. Finally, the Examiner has also rejected claims 16 and 20 under 35 U.S.C. 103(a) as being unpatentable over Hilti '209 in view of Brunstetter '193. The Examiner's rejections are respectfully traversed.

By way of introduction, the Applicant wishes to point out that the invention as now claimed exhibits two particularly significant features which, in synergy, provide a convenient and effective tool and method for guiding insertion of a nail into a surface:

Firstly, the device of the present invention employs a flexible membrane with an opening to engage and guide the nail. The use of a flexible membrane allows momentary resilient deformation of the opening in order to insert the head of a nail bigger than the size of the opening. This allows front loading of the device in a simple and intuitive manner while ensuring that the inserted nail is securely retained and accurately guided by the relatively small opening when unstretched.

Secondly, the membrane is deployed relative to abutment features of the device such that, when the device is abutting a surface, the portion of the flexible membrane guiding the nail is spaced away from the surface, thereby holding the nail more reliably than would a membrane flat against the surface. Graphically, the significance of these features may be illustrated as follows:



In case (1) above, the nail is guided by a resilient block rather than a membrane. Although the block provides effective support and guiding of the nail, the

block does not allow front loading or convenient release of a nail having a head larger than the bore through the block. Instead, headless nails must be used, or a lateral opening must be provided for releasing the nail head after use.

In case (2), the use of a resilient membrane allows front loading of a nail by momentary resilient deformation of the opening. However, when the device is brought into contact with a wall or other surface into which the nail is to be driven, the nail is pushed rearwards so that only the extreme tip of the nail contacts the membrane. In this position, the nail is not securely engaged, and may often fall inwards behind the membrane, leading to inconvenience and disruption of the nailing procedure.

Case (3) on the other hand illustrates the advantageous combination of the present invention. On one hand, the use of a flexible membrane allows front loading and easy release of nails with heads larger than the opening. At the same time, the spacing of the membrane away from the wall or other surface ensures that the nail is reliably and effectively supported throughout the nailing procedure.

Turning now to the specific references relied upon by the Examiner, the Hilti reference describes various versions of a stud driving device. The Examiner's reading of element 117 as a "flexible membrane" appears to be based upon a misunderstanding of the document. Element 117 is in fact a washer or "anchor disc" which remains in the wall with the stud at the end of the procedure to provide a "*fairly large base for receiving the stud in softer material,*" as detailed in column 4, lines 50-59. Certainly, the anchor disc is not sufficiently flexible to allow the head of the stud to pass through the opening since this would undermine its intended function as a base for the stud after insertion.

The Fields reference describes a nail driving device with a rubber tip portion 22 with a lateral slit 34 extending all the way to the side of the rubber block. This structure is analogous to case (1) illustrated above.

The Hoffman reference similarly has a resilient tip insert 13. The dimensions of the block do not allow for deformation to allow an oversize nail head to pass. The device is therefore illustrated only with small-head nails which fit through passage 14 through the insert.

The Brunstetter reference is an example of case (2) illustrated above, in which a rubber cap with an X-shaped slot for insertion and removal of nail head is brought into direct contact with the surface to be nailed.

In contrast to all of the above, the present invention provides a device and method for guiding nails into a surface wherein a flexible membrane with an opening is sufficiently flexible to allow insertion via the opening of the head of a nail having dimensions greater than dimensions of the opening, and which is deployed relative to abutment features of the device such that, when the device is abutting a surface, the portion of the flexible membrane guiding the nail is spaced away from the surface. This combination of features provides convenient front loading and removal of nails while also ensuring that the nail is effectively supported and guided throughout the nailing process. No such structure is either taught nor in any way suggested by the citations of record, considered alone or in combination.

While continuing to traverse the Examiner's rejections, the Applicant has, in order to expedite the prosecution, chosen to amend the claims in order to clarify and emphasize the crucial distinctions between the device of the present invention and the various patents cited by the Examiner. Specifically, new independent claims 20, 29 and 34 generally parallel original independent claims 1, 12 and 17 (prior to

renumbering), respectively, and have been amended to clarify that the membrane is sufficiently flexible to allow insertion via the opening of the head of a nail having dimensions greater than dimensions of the opening, and that the membrane is deployed relative to abutment features of the device such that, when the abutment features are brought into abutment with the surface, at least a portion of the flexible membrane adjacent to the opening is spaced away from the surface, thereby holding and guiding the nail throughout the drive-in operation.

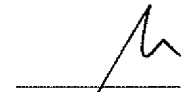
New dependent claims 21-28, 30-33, 35 and 36 generally parallel the original dependent claims with changes to avoid redundancy and render use of terminology consistent with the new wording of the independent claims. No new subject matter has been added.

Support for these amendments can be found in the specification. Specifically, support for the flexibility of the opening to expand and allow a nail head to pass through may be found on page 5, lines 8-9 or the application as filed. Support for at least the portion of the flexible membrane adjacent to the opening being spaced away from the surface to be nailed can be found in Figures 1(a), 1(c), 2(b) and 3(a).

Amended independent claims 20, 29 and 34 now feature language which makes it absolutely clear that the device of the present invention and the corresponding method employ a flexible membrane with an aperture deployed so as to be spaced from the surface to be nailed, and sufficiently flexible to allow front loading and easy removal of a nail head larger than the size of the opening. The Applicant believes that the amendment of the claims completely overcomes the Examiner's rejections on § 102(b) and § 103(a) grounds.

In view of the above amendments and remarks it is respectfully submitted that independent claims 20, 29 and 34, and hence also dependent claims 21-28, 30-33, 35 and 36, are in condition for allowance. Prompt notice of allowance is respectfully and earnestly solicited.

Respectfully submitted,



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Mark M. Friedman  
Attorney for Applicant  
Registration No. 33,883

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